

D. REMARKS**1. Status of the Claims**

Claims 1-6, 8-12, 14-18 and 20 are currently pending in the Application and stand rejected. Claims 1, 9, and 15 are independent claims and have been amended to include the limitations originally found in claims 7, 13, and 19, respectively, and claims 7, 13, and 19 have been cancelled. No claims have been added in this Response.

2. Examiner Interview

Applicants note with appreciation the Examiner Interview conducted between Applicants' attorney, Examiner Golinkoff, and Supervisory Examiner Kincaid on Tuesday February 17, 2004 at 1:00PM E.T. concerning related application (Serial No. 09/838,602). During the interview, the participants discussed the 102 reference of Lokuge (U.S. Pat. No. 6,252,597) and agreed that an amendment to the independent claims pointing out that the visual markers claimed by Applicants are "overlaid" would overcome the 102 objection.

The participants also discussed the statutory and obviousness type double patenting rejections. Applicants' attorney pointed out that the present application (Application No. 09/838,100) does not claim "overlaying." The participants agreed that amending the claims to point out that the visual markers are overlaid would also traverse the statutory type double patenting rejection and would also likely traverse the obviousness type double patenting objection. In a subsequent discussion with Examiner Golinkoff after Applicants filed their response to 09/838,602, Applicants agreed to cancel claims 6 and 14 of 09/838,602, through an Examiner's Amendment. These claims

dealt with alphanumeric level identifiers. Applicants' attorney and Examiner Golinkoff discussed amending the independent claims of the instant application (09/838,100) to include such alphanumeric level identifiers. These limitations were originally presented in claims 7, 13, and 19 of the instant application.. Applicants' attorney and Examiner Golinkoff agreed that such amendment would likely overcome the art, specifically Suzuki (U.S. Pat. No. 5,485,175), relied upon in the Office Action for related application no. 09/838,602. Applicant notes that the Examiner cites a different reference (U.S. Pat. No. 5,485,175 to Etchemendy et al.) in rejecting original claims 7, 13, and 19 of the present application. For reasons described hereinafter, the new reference also does not teach or suggest Applicants' claim limitations of alphanumeric level identifiers. Applicants' attorney and Examiner Golinkoff further agreed that such amendment would likely remove the double patenting rejections because the instant application requires alphanumeric level identifiers and does not "overlay" visual markers, while the related application has no claims directed to alphanumeric level identifiers and does require visual markers that are "overlaid."

3. Objections to the Drawings

Applicants note with appreciation the informalities noted by the Examiner in the figures. Applicants have prepared corrected drawings and have included a full set of corrected drawings with this Response. In light of these corrections, Applicants respectfully request the withdrawal of the objection to the drawings.

4. Objections to the Specification

Applicants note with appreciation the informality noted by the Examiner on page 16 of the specification. Applicants have amended this page of the specification to address the informality. In light of Applicants' amendment, Applicants respectfully request the withdrawal of the objection to the drawings.

5. Rejections: Alleged Double Patenting

Claims 1, 3, 8-9, 14-15, and 20 stand as being provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1 and 5-8 of co-pending Application No. 09/838,602. Applicants respectfully traverse the rejections. As discussed in Section 2, above, agreement was reached that, as amended, the claims of 09/838,602 are directed to "overlaying" a visual marker, while none of the claims in the instant application include a limitation of overlaying a visual marker in order to distinguish items being displayed. In addition, the claims of 09/838,602 have been amended canceling claims that are directed to displaying an alphanumeric level indicator. Conversely, each of the independent claims of the present application include limitations requiring an alphanumeric level indicator that indicates an item's level, or "data layer." In light of Applicants' amendments to the claims of the instant application as well as Applicants' amendments to the claims of co-pending Application No. 09/838,602, Applicants assert that the claims of the instant application are not obvious in light of co-pending Application No. 09/838,602. Therefore, Applicants respectfully

PATENT

request that the Examiner withdraw the provisional double-patenting rejection of claims 1, 3, 8-9, 14-15, and 20.

Applicants trust that the amendments to the instant application and the co-pending application are sufficient to overcome the double patenting rejection. However, if Applicants' amendments and remarks are insufficient to overcome the provisional double patenting rejection, Applicants agree to timely file a terminal disclaimer upon issuance of a Notice of Allowance of the instant application in order to overcome the provisional double patenting rejection.

**6. Rejections: 35 U.S.C. § 102, Alleged Anticipation and
 35 U.S.C. § 103, Alleged Obviousness**

Claims 1-4, 9-10, and 15-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,252,597 to Lokuge (hereinafter "Lokuge"). Applicants have amended independent claims 1, 9, and 15 to include the limitations originally found in claims 7, 13, and 19, respectively. Claims 7, 13, and 19 were rejected under 35 U.S.C. § 103 as being obvious and therefore unpatentable over Lokuge in view of U.S. Patent No. 5,999,182 to Etchemendy et al. (hereinafter "Etchemendy"). Therefore, Applicants respectfully traverse the rejections of the independent claims, as amended, as being rejected under 35 U.S.C. § 103 over Lokuge in view of Etchemendy.

The Office Action asserts that Lokuge teaches Applicants' invention as claimed in original claim 1 and cites various sections of Lokuge in support of this assertion. While both Lokuge and Applicants' invention address a common, general, shortcoming in the art (namely displaying hierarchical data),

they address the shortcomings in different and distinct ways. Lokuge teaches using a smaller font size for subcategory information in a hierarchical list (see Figure 7). In Figure 7, Lokuge shows the word "companies" in a larger font with examples of specific companies listed in a smaller font type underneath the "companies" category. Lokuge also teaches differentiating between items in other ways, as set forth in col. 7, lines 35-45:

In the example shown on the figures, the expansive locations are differentiated by color and by text descriptor ("news", "files"). In the example, the lower-tier contents of a particular category are displayed having the same color as the expansive location of the related upper-tier category. However, differentiation may be accomplished, for example by shading, highlighting, font size or shape, and category shape. For example, different expansive locations and tiers may be distinguished by use of different fonts, font size, scale, texture, color, sound, or by indentation, as well as by the inclusion of animation or video information. Furthermore, different tiers may have different configurations, such as the cluster arrangement, described in detail below.

In the preceding text, Lokuge describes using a laundry list of methods, while only teaching aspects regarding font sizes, indentation, and color. Importantly, however, and as discussed during the Examiner Interview, nowhere does Lokuge teach or suggest using alphanumeric level indicators as claimed by Applicants in amended claim 1. Instead, as illustrated by the preceding section, Lokuge teaches differentiating between hierarchical items using color and / or font size attributes on

the displayed items themselves, and does not teach or suggest using an overlaid visual marker, as taught and claimed by Applicants in amended claims 1, 9, and 16. Furthermore, the Office Action admits that Lokuge does not teach or suggest using alphanumeric level indicators in the rejection of original claims 7, 13, and 19, the limitations of which having been incorporated into independent claims 1, 9, and 14, respectively. However, the Office Action contends that Etchemendy teaches displaying an alphanumeric level identifier with each formatted data item that identifies the level corresponding to the formatted data item, citing Figure 5 and col. 6, lines 50-53 of Etchemendy in support of this contention and that it would be obvious to combine the teachings of Lokuge with those of Etchemendy.

Applicants respectfully disagree with the contentions made in the Office Action. As an initial matter, Applicants assert that Etchemendy does not teach or suggest displaying an alphanumeric level identifier with each formatted data item wherein the level identifier identifies the level corresponding to the formatted data item. Etchemendy is focused on "the creation, storing, display, and editing of a partially ordered set of nodes representing the steps in a reasoning process..." (Abstract). The lines of Etchemendy used in support of the contention made in the Office Action are the brief description of Figure 5 and merely state that "FIG. 5 illustrates a numbering scheme that reflects the recursive structure of a proof, in accordance with the teaching of the invention." (col. 6, lines 50-53). In other words, Etchemendy's figure, relied upon by the Office Action, shows the "structure of a proof" and does not indicate a level corresponding to a data item.

Etchemendy defines a "proof," the structure of which is shown in Figure 5, as follows:

"A proof is defined in the context of the present description as a data structure that records a logically structured reasoning process that represents a (possibly partial) execution of a reasoning task. A proof can be represented as an ordered sequence of steps (or nodes), each of which may contain a) a nonempty set of representational edits expressing incremental information about the subject matter of the reasoning task, b) information about what step in the proof or about the state of the proof as a whole at that step, or c) a nonempty set of subsidiary proofs (called subproofs). Thus, a proof is, in general, a recursive structure having subproofs which themselves may contain subproofs." (col. 7, line 66 - col. 8, line 10). Thus, using Etchemendy's own description, Etchemendy is not teaching or suggesting using an alphanumeric level identifier that identifies the level corresponding to a formatted data item.

First of all, in Figure 5, Etchemendy only shows a proof numbering scheme and does not teach or suggest displaying alphanumeric level identifiers "corresponding to a formatted data item," as taught and claimed by Applicants. Indeed, the only information shown in Etchemendy's Figure 5 is the proof numbering with absolutely no teaching or suggestion to display any "formatted data item" along with the proof number. Furthermore, Applicants contention is buttressed by the fact that Etchemendy's detailed specification only refers once to Figure 5 and describes the contents of Figure 5 as an example of a proof "numbering scheme." Etchemendy's detailed description states as follows:

FIG. 4c shows an example of annotational information about a state of a proof. FIG. 4b shows subproofs associated with nodes in a proof. Nodes in a proof, shown as small squares in the figures, may be numbered in various ways. One such numbering scheme that reflects the recursive structure of the proof is shown in FIG. 5.

Therefore, Applicants assert, there is absolutely no plausible support in Etchemendy to suggest that Etchemendy teaches or suggests displaying an alphanumeric level identifier that indicates the level of a corresponding data item. Etchemendy simply does not teach or suggest displaying a corresponding formatted data item and does not teach or suggest using such "proof numbering" in such a manner. Additionally, Etchemendy does not teach or suggest using the data shown on Figure 5 in a graphical user interface (GUI). Instead, the details of Etchemendy suggest that Figure 5 is merely showing "proof numbers" without any suggestion that such proof numbers are in any way used (or useful) in a GUI display. Therefore, Applicants further assert that the Office Action does not provide a *prima facie* basis to support an obviousness rejection under 35 U.S.C. § 103.

There is simply no motivation, found in the prior art, to combine the references of Lokuge and Etchemendy.

MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicant asserts that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because there is no motivation to combine the references. Lokuge teaches differentiating between displayed items using characteristics, such as font size, to differentiate between items. Etchemendy, on the other hand, teaches creation, storing, display, and editing of "proofs"

PATENT

without any teaching or suggestion of either using the "proof numbers" to differentiate between other formatted data items, nor to use the proof numbers in a GUI display, like that taught by Lokuge. Therefore, Applicants respectfully assert there is absolutely no motivation to combine the references.

Each of Applicants' independent claims include the same limitations of requiring an alphanumeric level identifier and, as discussed above, each of Applicants' independent claims is allowable over Lokuge in view of Etchemendy. The remaining claims each depend, directly or indirectly, on an allowable independent claim and, therefore, are each allowable for at least this reason.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By Joseph T. Van Leeuwen
Joseph T. Van Leeuwen
Attorney for Applicant
Registration No. 44,383
Telephone: (512) 301-6738
Facsimile: (512) 301-6742